

REMARKS

This amendment is being filed along with a Request for Continued Examination (RCE) application in response to the final Office Action having a mailing date of July 10, 2006. Claim 13 is canceled herein without prejudice. Claims 3 and 7 are amended as shown. New claims 14-16 are presented herein for consideration. With this amendment, claims 1-12 and 14-16 are pending in the application.

I. Preliminary matters

The final Office Action confirmed that claim 13 has been withdrawn from consideration due to a Restriction Requirement and due to the applicant's election of claims. Claim 13 is canceled herein without prejudice.

Claims 7-8 were objected to due to the recitation of a set of parentheses () in claim 7, which the final Office Action interpreted as a typographical error. It is noted herein that the parentheses () in previously presented claim 7 was intended to graphically depict the recited concave configuration of the crescent-shaped openings, and as such, was not a typographical error. However, to facilitate prosecution and to place claim 7 in better form, claim 7 is amended as shown to remove the parentheses (), and now recites "pairs of openings facing one another as an opposed concavity set." With this amendment to claim 7, it is kindly requested that the objection be withdrawn.

Claim 3 is amended to make a typographical correction.

II. Discussion of the claims and cited references

The final Office Action rejected claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over Stroppiana (EP 0 968 804 A2) in view of Smith (U.S. Patent No. 3,039,137) and Armstrong (GB 617,266). For the reasons set forth below, the applicant respectfully disagrees with this rejection and requests that the pending claims be allowed.

A. Discussion of independent claim 1

Independent claim 1 recites, *inter alia*, granular material (obtained from strips of material of different colors) that is mixed to render the granular material “substantially chromatically homogeneous.” The final Office Action cited page 3, lines 1-10 of Stroppiana as teaching a “substantially uniform surface appearance” that is “achieved by either using a chromatically homogeneous starting material or by blending different colored starting materials to form a chromatically homogeneous material.” This interpretation of Stroppiana is respectfully traversed herein.

Paragraph [0017] of Stroppiana (page 3, lines 4-6) relied upon by the final Office Action is reproduced below (emphasis ours) for reference:

“In particular, when a covering with a non-uniform appearance is to be produced, the strips are taken from an assortment of strips having two or more different colours. However, the invention may also be used to produce coverings of substantially uniform surface appearance.”

It is respectfully submitted that Stroppiana does not disclose, teach, or suggest “blending different colored starting materials to form a chromatically homogeneous material” as asserted by the Office Action. Thus, the above-quoted passage of Stroppiana cannot and should not be interpreted as meeting the limitations of claim 1 that recite “subjecting said granular material to mixing until it is rendered substantially chromatically homogeneous.”

To support the arguments against the assertions (the interpretation of Stroppiana) made in the final Office Action, enclosed herewith is a sworn declaration by Dr. G. Gambino. As specified in the declaration, Dr. Gambino has first-hand knowledge of the subject matter disclosed in Stroppiana. As stated by Dr. Gambino in paragraph 5(a) of his declaration, Stroppiana does not provide for a mixing operation of the granular material until the granular material is rendered substantially chromatically homogeneous. Instead and as explained by Dr.

Gambino in paragraph 6 of his declaration, Stroppiana can provide a “substantially uniform surface appearance” IF AND ONLY IF strips of one single color are used; and if using strips of different colors are used, the covering of Stroppiana presents a non-uniform appearance. Thus, Stroppiana clearly cannot meet the limitations of claim 1 that require both strips of material of “different colors” and granular material (obtained from said strips of material of different colors) that is rendered “substantially chromatically homogeneous” by mixing.

Accordingly, it is respectfully submitted that claim 1 is allowable over Stroppiana, whether singly or in combination with the other cited references.

To further illustrate the differences between Stroppiana and the present applicant’s process, Dr. Gambino’s declaration makes reference to Sample 1 and Sample 2, which are enclosed along with this amendment. Sample 1, which is manufactured according to the process of the prior art with strips of different colors, does not show a uniform appearance and in particular shows the different colors of green and white. Sample 2, which is manufactured according to the process of the present application with strips of different colours, presents chromatic homogeneity and in particular the color green, wherein the degree of chromatic homogeneity can be further increased with more extensive mixing of the granular material, as described in the present application.

Paragraph 5(b) of Dr. Gambino’s declaration further states that Stroppiana does not use gravity feeding of the granular material to a calender. The final Office Action also admitted on page 2 (bottom paragraph) that Stroppiana does not teach this feature. To supply the missing teachings of Stroppiana, the final Office Action cited Smith. However, it is respectfully submitted that Smith does not cure the deficiencies of Stroppiana.

Smith discloses an apparatus for forming plastic sheets, and, in particular, terrazzo floor or tiling comprising an embedment of multi-colored chips of stone in a base matrix generally of contrasting color. Terrazzo tiling has the appearance of random discrete color patches distributed in a background field or matrix of contrasting color. See, e.g., column 1, lines 12-16 and 24-30 of Smith. Thus, it is clear that the process and product of Smith do not provide chromatic homogeneity (since his floor/tile end products are multi-colored) and/or

further do not provide “direct feeding by gravity of the chromatically homogeneous granular material,” as recited in claim 1.

With respect to the specific way of feeding the calender rollers (*e.g.*, vertically by gravity) provided by the present applicant, this technique avoids the formation of a piled-up layer of raw material, whose chromatic characteristics cannot be controlled. In other words, the generation of a piled-up layer of raw material on a belt for horizontally feeding the compacting means (like those provided in Stroppiana and Smith) results in a further uncontrolled change in the chromatic composition of the layer of (not already chromatically homogeneous) raw material. In Stroppiana and Smith, the horizontal feeding of the press necessitates a layer of the granular material deposited on a feeding belt upon which the granular material is piled up, heaped up without any control.

Thus, it is respectfully submitted that claim 1 is further allowable over the cited references, whether singly or in combination.

The final Office Action has admitted on page 3 that Stroppiana does not teach “using calender rolls to form a strip.” To supply these missing teachings of Stroppiana, the final Office Action has cited Armstrong. However, Armstrong also does not cure the deficiencies of Stroppiana.

Armstrong relates to the manufacture of variegated plastic sheet material having a ground or base of one or more colors and a veined or swirl-grain pattern of contrasting or variegating color or colors, generally similar in appearance to marble. *See, e.g.*, page 1, lines 11-17 of Armstrong. Thus, the method of Armstrong, even if *hypothetically* construed to use calender rolls to form a strip, is not used in conjunction with granular material that is chromatically homogeneous so as to produce a chromatically homogeneous strip from the calendering.

Thus, claim 1 is also allowable over Stroppiana and Armstrong, whether singly or in combination.

It is therefore noted here for the record that the Office Action appears to be trying to use the claimed invention as a blueprint to combine various features of the prior art to arrive at the claimed subject matter. It is well settled that such use of hindsight is impermissible as a

matter of law. *In re Gorman*, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). It is the prior art references themselves that must suggest the combination. *Kimberly Clark v. J & J*, 223 U.S.P.Q. 603 (Fed. Cir. 1984). *See also Fromson v. Advanced Offset Plate*, 755 F.2d 1549, 1556 (Fed. Cir. 1985). The cited references, as explained above and in previous responses, clearly do not teach or suggest the limitation of granular material that is mixed to render it chromatically homogeneous, and instead teach processes that are intended to produce multi-colored products. Thus, a person skilled in the art would not look to these techniques for a process that requires granular material that is chromatically homogeneous, so as to produce in the end strips that are chromatically homogeneous.

Further, the Examiner *must* take the references in their entirety, and cannot simply ignore portions that *teach away* from the claimed subject matter or otherwise argue against obviousness. *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986). It is impermissible to pick and choose from a reference only so much of it as will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of what the reference fairly suggests to one skilled in the art. *Id* at 419. The courts have long cautioned that consideration *must* be given “where the references diverge and *teach away* from the claimed invention.” *Akzo N.V. v. International Trade Commission*, 1 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1986). In other words, the Examiner has not explained why one skilled in the art would ignore the clear and unambiguous teachings of Smith’s and Armstrong’s processes that specifically intend to produce multi-colored products, which in fact teaches away from the limitations of claim 1. Instead the Examiner has chosen to isolate their alleged specific teachings of “feeding by gravity” and “calender rollers,” respectively, and apply these out-of-context teachings into Stroppiana to arrive at a conclusion that these references in combination meet the limitations of chromatic homogeneity of the granular material that is fed by gravity into a calender.

B. Discussion of the new claims

The manufacturing process of Smith provides for the arrangement of the granules in a thin bed, which shall be compacted by a rotatably driven heated drum around an arcuate

portion. There is not any description in Smith of a vertical feeding by gravity of the compacting means. As clearly shown in Figures 1 and 3 of Smith, his feeding is a horizontal feeding. New claim 15 recites “direct vertical feeding by gravity of the chromatically homogeneous granular material into the gap between rollers of the calender,” and is thus allowable over Smith and Stroppiana (neither of which directly vertically feed chromatically homogeneous material into a calender by gravity).

Dependent claim 15 recites that “wherein said strip that has been subjected to vulcanization is chromatically homogeneous.” This limitation distinguishes over Smith and Armstrong, for instance, since they respectively produce strips that are multi-colored or marble-like.

Dependent claim 14 recites “wherein a degree of chromatic homogeneity of said covering can be increased based on extensiveness of said mixing.” These features are not provided by any of the cited references, since for example, Smith and Armstrong do not have chromatic homogeneity in their multi-colored end products. Further, Stroppiana does not provide the recited mixing. Thus, claim 14 is allowable.

III. Conclusion

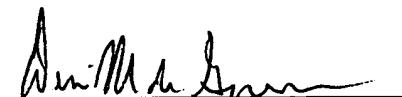
Overall, none of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, given the above amendments and accompanying remarks, the independent claims are now in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 622-4900.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
SEED Intellectual Property Law Group PLLC



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DMD:wt

Enclosure:

Declaration of Dr. Giampietro Gambino
Samples 1 & 2

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